FEB 16 2001

No. 00-201

Supreme Court, U.S.
FILED
FEB 16 2001
OFFICE OF THE CLERK

IN THE
Supreme Court of the United States

THE NEW YORK TIMES COMPANY, INC.; NEWSDAY, INC.; THE TIME INCORPORATED MAGAZINE COMPANY; LEXIS/NEXIS and UNIVERSITY MICROFILMS INTERNATIONAL,
Petitioners,

v.

JONATHAN TASINI; MARY KAY BLAKELY; BARBARA GARSON; MARGOT MIFFLIN; SONIA JAFFE ROBBINS and DAVID S. WHITFORD,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Second Circuit

---

BRIEF OF *AMICI CURIAE* AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS, INC. *ET AL.* IN SUPPORT OF RESPONDENTS

VICTOR S. PERLMAN
AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS
150 North Second Street
Philadelphia, PA 19106-1912

L. DONALD PRUTZMAN
Counsel of Record
ANDREW BERGER
TANNENBAUM HELPERN SYRACUSE & HIRSCHTRITT LLP
900 Third Ave.
New York, NY 10022
(212) 508-6700

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20001

BEST AVAILABLE COPY

TABLE OF CONTENTS

	Page
INTERESTS OF *AMICI CURIAE*	1
SUMMARY OF ARGUMENT	5
ARGUMENT	9
I. THE LEGISLATIVE HISTORY OF SECTION 201(c) DEMONSTRATES THAT IT WAS INTENDED TO PROTECT AUTHORS' COPYRIGHTS IN CONTRIBUTIONS TO COLLECTIVE WORKS AND TO GRANT PUBLISHERS LIMITED RIGHTS IN THOSE CONTRIBUTIONS	9
A. Background of the 1909 Act	10
B. The Register's 1961 Report	11
C. The Debate over the Register's Recommendation	12
D. The 1964 Draft Bills	15
E. The 1965 Draft Bill and Register's Supplementary Report	17
F. The 1976 House Report	20
G. The Current Register's Views	21
II. THE DIRE CONSEQUENCES PREDICTED BY PETITIONERS AND THEIR *AMICI* ARE OVERSTATED AND MISLEADING	22

TABLE OF CITED AUTHORITIES

CASES: Page

Abend v. MCA, Inc., 863 F.2d 1465 (9th Cir. 1988), *aff'd on other grounds sub nom. Stewart v. Abend*, 495 U.S. 417 (1990) 24
Amoco Prod. Co. v. Village of Gambell, 480 U.S. 531 (1987) 24
Center for Creative Non-Violence v. Reid, 490 U.S. 730 (1989) 9
Dun v. Lumbermen's Credit Ass'n, 209 U.S. 20 (1908) 24
Friends of the Earth, Inc. v. Laidlaw Envtl. Servs. (TOC), Inc., 528 U.S. 167 (2000) 24
Geisel v. Poynter Prods., Inc., 295 F. Supp. 331 (S.D.N.Y. 1968) 11
Richard Feiner & Co. v. Turner Entm't Co., 98 F.3d 33 (2d Cir. 1996) 24
Shapiro, Bernstein & Co. v. Bryan, 123 F.2d 697 (2d Cir. 1941) 10
Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417 (1984) 24, 25
Tasini v. New York Times Co., 206 F.3d 161 (2d Cir. 2000) 18
Tasini v. New York Times Co., 972 F. Supp. 804 (S.D.N.Y. 1997) 14
Universal City Studios v. Sony Corp. of Am., 659 F.2d 963 (9th Cir. 1981), *rev'd on other grounds*, 464 U.S. 417 (1984) 24
Weinberger v. Romero-Barcelo, 456 U.S. 305 (1982) 23, 24

STATUTES:

1976 Act, Pub. L. No. 94-553, 90 Stat. 2541
17 U.S.C. § 201(c) ..... *passim*
17 U.S.C. § 502(a) 23

TABLE OF CITED AUTHORITIES—Continued

	Page
1909 Act, ch. 320, 35 Stat. 1075	
17 U.S.C. § 1	10
17 U.S.C. § 3	6, 10
17 U.S.C. § 10	10
OTHER AUTHORITIES:*	
147 Cong. Rec. E182 (daily ed. Feb 14, 2001) (letter from Marybeth Peters, Register of Copyrights, to Hon. James P. McGovern)	*passim*
Copyright Clearance Center, *CCC Services*, *at* http://www.copyright.com/Services/services_Portal.html (last visited Feb. 9, 2001)	25
Copyright Law Revision, Part 1	12
Copyright Law Revision, Part 2	12, 13, 14
Copyright Law Revision, Part 3	14
Copyright Law Revision, Part 5	15, 16, 17
Copyright Law Revision, Part 6	17, 18, 19
Encyclopaedia, *Encyclopædia Britannica Online*, *at* http://search.eb.com/bol/topic?eu=108517&sctn=24 (last visited Feb. 9, 2001)	14
H.R. 11947, 88th Cong. (1964)	16
H.R. Rep. No. 1476	20, 21
National Writers Union, *About the Publications Rights Clearinghouse*, at http://www.nwu.org/prc/prcabout.htm (last modified July 29, 1999)	25
3 Melville B. Nimmer & David Nimmer, Nimmer on Copyright (2000)	11, 24

* Where abbrieviated, references to the legislative history correspond to the designations in the Table of Citation Conventions Used in This Brief listed *infra* at v-vi.

TABLE OF CITED AUTHORITIES—Continued

	Page
S. 3008, 88th Cong. (1964)	16
Study 11	10, 11
Webster's Third New International Dictionary (1993 ed.)	19

TABLE OF CITATION CONVENTIONS USED IN THIS BRIEF

For clarity and ease of reference, *Amici* have adopted the same short form citations for legislative materials used by the Petitioners in their opening brief, which are reprinted below for the Court's convenience.

Full Title of Source	Short Form
Statutes	
Copyright Act of 1976, *codified at* Title 17, U.S.C.	"Act" or "1976 Act"
Copyright Act of 1909, ch. 320, 35 Stat. 1075 (*codified at* former Title 17, U.S.C.), *repealed by* Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (effective January 1, 1978)	"1909 Act"
Congressional Committee Reports	
H.R. Rep. No. 1476, 94th Cong., 2d Sess. (1976), reprinted in 1976 U.S. Code Cong. & Ad. News 5659	"H.R. Rep. No. 1476"
S. Rep. No. 473, 94th Cong., 1st Sess. (1975)	"S. Rep. No. 473"
H.R. Rep. No. 1476, 94th Cong. 2d Sess. (1976)	"H.R. Rep. No. 1476"
Copyright Law Revision Studies and Reports	
Studies Prepared for the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary, 86th Cong., 2d Sess., Study No. 11, Divisibility of Copyrights (A. Kaminstein) (1960)	"Study 11"

TABLE OF CITATION CONVENTIONS—Continued

Full Title of Source (cont'd)	Short Form
Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess., Copyright Law Revision (H. Judiciary Comm. Print 1961)	"Copyright Law Revision Part 1"
Discussion and Comments on Report of the Register of Copy-Rights on the General Revision of the U.S. Copyright Law, 88th Cong., 1st Sess. Copyright Law Revision, Part 2 (H. Judiciary Comm. Print 1963)	"Copyright Law Revision Part 2"
Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 2d Sess., Copyright Law Revision, Part 3 (H. JudiciaryComm. Print 1964)	"Copyright Law Revision Part 3"
1964 Revision Bill with Discussions and Comments 89th Cong., 1st Sess., Copyright Law Revision, Part 5 (H. Judiciary Comm. Print 1965)	"Copyright Law Revision, Part 5"
Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright law; 1965 Revision Bill, 89th Cong., 1st Sess., Copyright Law Revision, Part 6 (H. Judiciary Comm. Print 1965)	"Copyright Law Revision, Part 6"

INTERESTS OF AMICI CURIAE

The American Society of Media Photographers, Inc., *et al.* respectfully submit this brief as *amici curiae* in support of the Respondents Jonathan Tasini, *et al.* (collectively "Respondents") in this case. A complete listing of the twenty organizations comprising the *amici curiae* is set forth in Appendix A to this brief.[1]

The *amici curiae* organizations supporting the Respondents in this case represent the interests of a substantial proportion of freelance creators in the United States. In particular, the membership of the *amici* organizations include thousands of freelance photographers, writers, graphic artists, fine artists and cartoonists (collectively "freelance authors") who produce an enormous range of creative material for publications distributed throughout the world, and for other clients outside of the publication arena.

The vast majority of the freelance authors represented by *amici* retain the copyrights to their creative works. They do so because preserving, and to the extent possible exploiting, the economic value of those copyrights are essential to their economic survival. Whether their works are created on assignment for a client (*e.g.*, shooting photographs in Bosnia for a national news magazine) or on their own initiative, the freelance authors represented by *amici* rely heavily on their copyrights for their livelihoods, and in many cases for their retirements. In fact, it is precisely the creative talents of freelance authors such as those represented by *amici* that the copyright laws are intended to nurture and sustain.

---

[1] Pursuant to this Court's Rule 37.6, *amici* state that no counsel for any party authored this brief in whole or in part, and that no person or entity other than *amici*, its members, or its counsel, made a monetary contribution to the preparation or submission of this brief. The parties have consented to the filing of this *amici curiae* brief, and letters evidencing such consent have been filed with the Clerk of this Court, pursuant to S. Ct. R. 37.3.

These freelance authors have two principal interests in this case. The first interest is one that they share with all those who have an economic stake in an information age now at the beginning of a digital revolution. That interest is, in short, the right to participate in new markets for the reuse of published material, and thus to secure new potential sources of income.

The rapid pace of technological change in an increasingly information-based economy has opened up new and potentially lucrative markets for what is colloquially called "content." Publishers and other content distributors interested in exploiting these new markets can choose from a variety of media, ranging from print to multiple forms of digital media, in offering customers access to content. However technologically advanced or easily accessible these products or services may be in terms of use, their commercial success is nevertheless largely determined by the quality and appeal of the content itself.

Freelance authors, no less than publishers, wish, and are entitled, to participate economically in the new markets for their works opened up by relatively new technologies such as digital media. Freelance authors are, like publishers, in the business of disseminating their works to the public. Publication photographers, for example, such as those represented by the American Society of Media Photographers (one of the *amici* submitting this brief), take photographs that they believe will be of interest to others. Publication photographers want their photographs to be seen and appreciated by the widest possible audience, for that is how they establish their reputations and, consequently, their value in the marketplace.

It should go without saying that freelance authors expect to be compensated for the widespread dissemination of their works by publishers and others. For freelance authors, this case presents the question whether they can assert their copyrights to demand payment for the repackaging and reuse

of their content into "new media" products and services. The issue is not, as Petitioners portray it, whether freelance authors can or will use their copyrights to restrict dissemination of their works in such new media. That specter, conjured up by Petitioners and their *amici*, is consistent neither with the realities of the marketplace nor with the real-world objectives of freelance authors who want their works to be seen and appreciated by the public. Instead, the central issue in this case is whether freelance authors will be compensated for the repackaging and reuse of their works in new media. Petitioners wish to be the *only* beneficiaries of the economic potential of these new media. Freelance authors simply wish to *share* in this economic exploitation of their works.

The second interest of freelance creators in this case is closely related to the first: it is to ensure the opportunity to realize the economic potential of their copyrighted works before their value is damaged or destroyed through worldwide and instantaneous distribution by digital media such as computer-based databases. While new media create opportunities for broader and more efficient distribution of copyrighted materials, digital media such as NEXIS also present the danger that the authors' future markets for those works may effectively be destroyed. The instant availability of an article on NEXIS, for example, enables millions of people to gain access to the work via their computers. The widespread dissemination of copyrighted articles and photographs through other digital media such as CD-ROM often effectively precludes any further licensing of the works on a limited, or even any, basis. The ease of digital distribution of copyrighted materials may further impede, if not destroy, the non-exclusive licensing market for the works. In short, the *only* opportunity for freelance authors to obtain some economic return from the reuse of their works (beyond the compensation paid by publishers for one-time use of the material) is when they are dumped indiscriminately into large

databases available to millions by pressing a key on their computers. Thereafter, it is unlikely that anyone would be interested in paying the authors for the use of those works.

This conclusion is reinforced by the views of the current Register of Copyrights, Marybeth Peters. In a letter to Congressman James P. McGovern expressing her views on this case, the Register observed that "freelance authors have experienced significant economic loss since" the enactment of the 1976 Act. 147 Cong. Rec. E182 (daily ed. Feb. 14, 2001) (attached hereto as Appendix B), App. B 4a. This loss has occurred, in the Register's judgment, in part because of the unequal bargaining power between authors and publishers. *Id.* Significantly, however, this loss has also been caused by the impact the digital revolution has had on what used to be a thriving secondary market for authors' contributions to collective works. *Id.* Now that these contributions are readily accessible through electronic media such as NEXIS, no other publication, whether it be regional, national or a syndicate, is willing to pay the authors of such contributions for further uses of these works. *Id.* At the same time, according to the Register, that same digital revolution "has given publishers opportunities to exploit authors' works in ways barely foreseen in 1976." *Id.*

Finally, the hard reality Petitioners never mention is that they have traditionally paid *only* for one-time publication of the works of freelance authors. For example, *The New York Times* currently pays freelance photographers a day rate of $150. *See* Second Cir. J.A. at A123, A295-96. This means that, for that money, *The New York Times* receives as many photographs as the photographer shoots on the day's assignment, along with the first-time, one-time right to publish as many of those photographs as it chooses. These sums bear no relation to the downstream value of the works when they are republished in databases or CD-ROMs, and they have not changed significantly since the days long before digital databases and CD-ROMs were even heard of.

There is no negotiation over what additional compensation should be paid for the reuse; publishers take the position that none is owed to the creators of the works because of section 201(c). Thus, the stark facts are that for a few hundred dollars, publishers claim the right initially to publish freelance articles and photographs, and then to drop them into databases and other media for further distribution for the exclusive benefit of publishers and their secondary distributors.

As demonstrated below, and as further supported by the views of the Copyright Office regarding a provision that it was instrumental in drafting, this was not the bargain struck by authors and publishers, under the leadership of the Copyright Office, when the terms of section 201(c) were crafted and subsequently adopted by Congress. The unilateral reuse of authors' works in databases and other media goes well beyond the narrow grant under section 201(c) of the right to use photographs and articles in "any revision" of "that collective work" in which they first appeared. Accordingly, publishers and distributors of new media collections of collective works must be required to pay fair compensation to authors for this unauthorized reuse of their copyrighted works.

SUMMARY OF ARGUMENT

This case presents an old problem in a new guise. As is so often the case in statutes this Court has occasion to interpret, Congress did not define a key statutory term—"any revision" in section 201(c)—that has become a major point of dispute between authors and publishers. The origins of that dispute are found in the events and negotiations preceding the enactment of section 201(c) and the rest of the 1976 Copyright Act. Those origins shed light on the true nature of the compromise crafted by the Copyright Office a decade before Congress eventually codified it in section 201(c) of the 1976 Act.

Under the terms of that bargain, authors were given the assurance that they had been lacking under the 1909 Act: presumptive copyright ownership of their contributions to collective works. Publishers were accorded certain limited rights to use authors' contributions—limited rights that were painstakingly negotiated and that were plainly meant to be subsidiary to the fundamental purpose of enhancing the copyright status of authors. Section 201(c), therefore, was enacted to rectify the unintended impact of the 1909 Act on the rights of authors, and to codify certain trade practices that reflected a fair allocation of rights between authors and publishers. Under the "indivisibility" doctrine of the 1909 Act, publication of a "composite" (now collective) work under the publisher's copyright notice vested copyright in the entire collective work, including the author's contribution, in the publisher. 17 U.S.C. § 3 (1909 Act). The author thus became the mere licensee of his contribution, and was effectively foreclosed from protecting his rights in the contribution.

Against that backdrop created by the 1909 Act, authors and publishers struggled to define their respective rights to contributions to collective works such as newspapers, magazines and encyclopedias. In the case of newspapers and magazines, publishers were generally given "first publication" rights only. With respect to certain kinds of collective works such as encyclopedias, publishers would have received the additional right to republish the contribution in later editions of the collective work. The 1909 Act was generally viewed by the participants on both sides as impeding rather than facilitating these transactions.

Section 201(c) of the 1976 Act swept away the legal obstacles erected by the 1909 Act to the authors' transfers of limited rights in contributions to collective works while retaining copyright ownership of those contributions. In the words of the current Register of Copyrights, "[s]ection 201(c)

was intended to limit a publisher's exploitation of freelance authors' works to ensure that authors retained control over subsequent commercial exploitation of their works." 147 Cong. Rec. E182 (daily ed. Feb. 14, 2001), App. B 4a. That purpose would be thwarted if section 201(c) is construed, as urged by Petitioners, to give publishers of collective works "an unintended windfall" at the expense of authors. *Id.* at 3.

Between 1961 and 1965, when the Register of Copyrights prepared the first and last drafts of what became section 201, authors and publishers, together with the Copyright Office, negotiated the terms of a compromise that freed authors from the shackles imposed by the 1909 Act and gave publishers certain limited rights in those contributions, consistent with then-prevailing trade practices. Nothing in that compromise effectuated the open-ended grant to publishers that Petitioners urge should now be adopted as this Court's statutory interpretation.

Acceptance of Petitioners' twisted interpretation of section 201(c) would be a perverse and tragic outcome. Rather than view section 201(c) as what it was—an effort to restore authors' copyrights in their contributions and at the same time grant publishers certain limited rights in those contributions consistent with then-prevailing trade practices—Petitioners would have this Court adopt an interpretation that would effectively eviscerate authors' copyrights in their contributions. This is precisely the opposite result sought to be achieved by the compromise negotiated by authors, publishers, and the Copyright Office, and intended by Congress when it codified this compromise in section 201(c). The essence of that compromise is the *reaffirmation* of authors' copyrights in their contributions and the *limited grant* to publishers of the "privilege" of including the contributions in any revisions of that particular work—not, as the Petitioners would have it, in subsequent collections of

collective works such as those found in NEXIS. As the Register of Copyrights has succinctly put it:

> Although "revision" is not defined in Title 17, both common sense and the dictionary tell us that a database such as NEXIS, which contains every article published in a multitude of periodicals over a long period of time, is not a revision of today's edition of The New York Times or last week's Sports Illustrated.

147 Cong. Rec. E182, E183 (daily ed. Feb. 14, 2001), App. B 8a.

Petitioners and their *amici* seek cover for their attempted rewriting of section 201(c) by claiming that the alternative would destroy databases and impair the historical record. These apocalyptic predictions are as false here as they are in other contexts. Affirmance of the Second Circuit would not require publishers to remove freelance authors' contributions from databases, but rather simply to pay for their reuse. Finding and negotiating with freelance authors is neither impractical nor impossible, as Petitioners and their *amici* claim. If Petitioners and their *amici* can find and remove freelance author contributions from their databases—a process they claim has already begun—they can, if required to do so, negotiate reasonable fees for reuse of the authors' material in digital media.

Finally, the Act confers upon the federal courts broad latitude to draft appropriate relief that does not wreak the havoc that publishers and their *amici* predict. Federal courts are empowered to deny broad permanent injunctive relief to prevailing plaintiffs in appropriate circumstances and to fashion narrower injunctive relief coupled with monetary remedies that reflect past and future payments for continuing reuse of authors' contributions. There is no basis in law or practice for Petitioners' ominous warnings about the impending destruction of databases and new media that they claim would flow from rejection of their argument. In fact, as

the Register of Copyrights has suggested, recognition of authors' rights in this litigation would not necessarily, or even preferably, result in an injunction; the better result, in the Register's view, would be "a monetary award that would compensate the authors for past and continuing unauthorized use of their works." 147 Cong. Rec. E182, E183 (daily ed. Feb. 14, 2001), App. B 10a.

The real consequence of affirmance of the Second Circuit's decision—and the outcome that Petitioners really fear—is that they would have to pay fair compensation for their unilateral and unauthorized reuses of authors' contributions to collective works. The Respondents in this case, and freelance authors everywhere, are entitled to no less.

ARGUMENT

I. THE LEGISLATIVE HISTORY OF SECTION 201(c) DEMONSTRATES THAT IT WAS INTENDED TO PROTECT AUTHORS' COPYRIGHTS IN CONTRIBUTIONS TO COLLECTIVE WORKS AND TO GRANT PUBLISHERS LIMITED RIGHTS IN THOSE CONTRIBUTIONS

As this Court has recognized, the legislative history of the 1976 Copyright Act is an indispensable resource in divining the intent of Congress. *See Center for Creative Non-Violence v. Reid*, 490 U.S. 730, 747-48 (1989). That legislative history is particularly useful where, as here, Congress did not expressly define the critical statutory phrase that has led the parties to this Court: the meaning of "any revision of that collective work" in section 201(c).[2]

---

[2] While Petitioners purport to address the plain meaning of this language, their analysis of "any revision" largely ignores the significance of the statutory phrase "that collective work." As the Second Circuit properly understood, the phrase by its terms does not authorize "any

A. Background of the 1909 Act

The 1909 Copyright Act did not expressly distinguish between the copyright in a "composite work" (as collective works were then known) and the copyright in a contribution to such a work. *See, e.g.*, 17 U.S.C. §§ 1, 3, 10 (1909 Act); *see also Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 699 (2d Cir. 1941) (noting that a composite work is a work "to which a number of authors have contributed distinguishable parts which they have not however separately registered"). Instead, the 1909 Act spoke in terms of a single copyright owned by a single proprietor. 17 U.S.C. §§ 1, 3, 10 (1909 Act). Accordingly, when an author transferred rights to a publisher in an article or photograph, the entire copyright in such a work passed by statute to the publisher. 17 U.S.C. § 3 (1909 Act). As an early Copyright Office study recognized, "the transferee of less than all the rights [the author] may be regarded as a mere licensee and cannot sue to enforce his rights without joining the owner of the residual rights [the publisher]." Study 11 at 1.

Compounding the problem, the 1909 Act did not trigger statutory copyright protection until a work was published with the required copyright notice. 17 U.S.C. § 10 (1909 Act). Publication of a "composite work" under the publisher's copyright notice vested statutory copyright in the entire work, including the contributions, in that publisher. *Id.* § 3.

---

revision" in a vacuum, but rather with respect to a specific *preexisting* work—the particular collective work in which the author's contribution was published. Petitioners do not and cannot explain how a NEXIS database comprising a compendium of selections from a multitude of collective works could possibly be considered as fairly encompassed by the plain meaning of "any revision of that collective work." *See* 147 Cong. Rec. E182, E183 (daily ed. Feb. 14, 2001) (statement of Register of Copyrights) ("Although NEXIS may contain all of the articles from today's New York Times, they are merged into a vast database of unrelated individual articles."), App. B 8a.

These aspects of the 1909 Act scheme "greatly impeded" commercial transactions, producing "technical pitfalls" for both authors and publishers. 3 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 10.01[B], at 10-7 (2000). Courts relied on "trade custom" to determine what rights were conveyed, and authors were at risk of a finding that they ceded the entirety of their copyright to a publisher, however unintentionally. *See* Study 11 at 18, 21; *see also Geisel v. Poynter Prods., Inc.*, 295 F. Supp. 331, 337 (S.D.N.Y. 1968) (dispute over custom and practice in the magazine publishing arena in 1932). Predictability regarding the legal consequences of transactions involving copyrights became a casualty of the 1909 Act scheme.

Other unintended consequences worked further hardships on authors of contributions to collective works. Authors became mere licensees of the right to use their contributions as a result of having ceded their copyrights in such works to the publishers. Without joining the publishers in an infringement action, authors could not prevent others from using their contributions. Study 11 at 21. If the publisher went bankrupt or could not be found, authors were helpless to stop infringers. Furthermore, the uncertainty over the legal status of conveyance of rights in a contribution to publishers left authors in the untenable position of having to prove what rights they retained, if any, in a transaction with the publisher involving a contribution to a composite work. *Id.* at 18, 21.

B. The Register's 1961 Report

The foundation for what became section 201(c) was laid by the Register of Copyright's Report on the General Revision of the U.S. Copyright Law issued in 1961. Addressing the uncertainty concerning the allocation of rights in a composite work, the Register put forth the following recommendation:

> In the case of a periodical, encyclopedia or other composite work containing the contributions of a number of authors, the publisher should have the right to secure copyright. The copyright secured by the publisher in the composite work as a whole should cover all of the contributions not separately copyrighted; but the publisher should be deemed to hold in trust for the author all rights in the author's contribution, except the right to publish it *in a similar composite work* and any other rights expressly assigned.

Copyright Law Revision, Part 1 at 88 (emphasis added).

Under this formulation, the author would retain, albeit through a "trust" held by the publisher, all rights in his contribution, with one notable exception (the other being a general reference to "other rights expressly assigned"). That exception—the right to publish the contribution "in a similar composite work"—was the first step toward carving out certain specified rights in the contribution for the benefit of publishers. But the starting principle for this formulation was that the author would retain *all* rights in the contribution except for those specified in the provision. This principle remained unchanged and was the foundation of section 201(c) as enacted.

C. The Debate over the Register's Recommendation

Not surprisingly, the Register's recommendation ignited controversy. Authors' representatives, such as Harriet Pilpel, expressed concern that the proposed "carve-out" for publishers to use the contribution "in a similar composite work" was more than what many authors were prepared to give. Copyright Law Revision, Part 2 at 151, J.A. 568a (statement of Harriet Pilpel). Ms. Pilpel noted that under current law (the 1909 Act), an author was free to argue that "all he gave the publisher was the right to include his contribution *in that particular composite work.*" *Id.*

(emphasis added). Echoing this concern, another participant in the debate representing the recording industry proposed that the phrase "similar composite work" be replaced by a reference to "that particular composite work," thus insuring that the publisher could only use the contribution in the specific collective work in which it was to be first published (unless, of course, the parties expressly agreed otherwise). *Id.* at 153.

Another authors' representative explained this approach in terms of a presumption, once again a concept that was ultimately accepted (though the exceptions would be expanded at the publisher's behest, as discussed below):

> [W]here a short story is published in a magazine, it should be presumed that the publisher has acquired only the first serial right, or first magazine right, or whatever you call it—the right to publish in that edition—and that, in the absence of a specific assignment of other rights by the author in writing, recorded, no one would be free to presume that the publisher owned anything else, and would have to deal with the author.

Id. at 152, J.A. 570a (statement of Irwin Karp).

While extending a publisher's rights in a contribution to use in "a similar composite work" went too far for authors, their proposed restriction of a publisher's use of a contribution to the "particular composite work" did not go far enough for publishers. One of the leading spokesmen for the publishers, Horace Manges, raised the question whether "a revised edition of a composite work" would be encompassed by the phrase "that particular composite work." *Id.* at 153, J.A. 571a. The authors' response was most definitely not. *Id.* at 153, J.A. 571a-572a (statement of Irwin Karp). In response, textbook and encyclopedia publishers proposed an expanded carve-out designed to allow publishers to use the contribution in "revised editions" of composite works other than periodicals (thus excluding newspapers from the benefit

of this broadened exception).[3] *Id.* at 230, Lodging Vol. I at L-19.

The Register initially resisted accommodation of publishers' concerns about "revised editions." *See* Copyright Law Revision, Part 3 at 15, J.A. 579a.[4] But the publishers persisted, raising questions whether "a volume containing only half the material in 'that particular collective work'" would nevertheless be considered as encompassed within the publishers' presumptive privilege regarding "that particular collective work." *Id.* at 261, J.A. 591a (statement of Bella Linden).[5]

---

[3] The concern expressed by textbook and encyclopedia publishers reflected existing trade custom. For magazines and newspapers, the trade custom was to convey only first serial rights. Copyright Law Revision, Part 2 at 152, J.A. 570a. Indeed, that is what the district court held the parties intended to convey here. *See Tasini v. New York Times Co.*, 972 F. Supp. 804, 812 (S.D.N.Y. 1997) (finding that the conveyance of first serial rights was at issue but that "right to publish an article 'first' cannot reasonably be stretched into a right to be the first to publish an article in any and all mediums").

In contrast, the custom of encyclopedia publishers was markedly different. Thirty-volume encyclopedias were not created anew each year; any contributor had to realize that. *See* Encyclopaedia, *Encyclopædia Britannica Online*, at http://search.eb.com/bol/topic?eu=108517&sctn=24 (last visited Feb. 9, 2001) (observing that "most major encyclopaedias" used "a system of continuous revision" in which "some percentage of the articles in a set are updated or improved in other ways on a flexible schedule," and that several publishers were able "to reprint their sets on an annual basis and to introduce into each new printing as many revised entries as possible").

[4] Hence the next version of the draft bill accorded publishers "only the privilege of publishing the contribution in that particular collective work." *Id.*

[5] Petitioners seize on this statement from the legislative history as support for their contention that the removal of photographs from daily editions of *The New York Times* and the use of the digitized text from those editions in databases such as NEXIS do not destroy their status as

D. The 1964 Draft Bills

The publishers' concerns were reflected in the Register's next draft, which was introduced to Congress in 1964 as a proposed general revision of the copyright laws. Section 14(c) established the basic principle that the author owned the copyright in his contribution subject to certain presumptive rights of the collective work publisher—including, for the first time in the debate over this subject, the right to use the contribution in "any revisions" of the "particular collective work" in which the contribution was initially published:

> (c) CONTRIBUTIONS TO COLLECTIVE WORKS.—Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, *the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work and any revisions of it.*

"revisions." Pet'rs Br. at 30-31. But petitioners' argument fails to consider the rest of the statutory language at issue. The question under section 201(c) is whether the reuse in NEXIS of textual material taken from daily editions of *The New York Times* constitutes "any revision of that collective work"—namely, "any revision" of the daily editions of *The New York Times* from which the articles were taken. No reasonable reading of the entire statutory language at issue can support Petitioners' argument that a NEXIS database or a compendium of daily editions of *The New York Times* on CD-ROM should be considered revisions of *those daily editions*. The NEXIS database, for example, is not a revision of any one edition of *The New York Times*; it is simply a compendium of all of those editions, with photographs and many other portions of the original editions removed. *See* 147 Cong. Rec. E182, E183 (daily ed. Feb. 14, 2001) (statement of Register of Copyrights) (stating the conclusion of the Register that the NEXIS database "is, at best, a 'new anthology,' and it was Congress' intent to exclude new anthologies from the scope of the § 201(c) privilege."), App. B 8a.

Copyright Law Revision, Part 5 at 9, J.A. 604a (emphasis added); *see* S. 3008, 88th Cong. § 14(c) (1964); H.R. 11947, 88th Cong. § 14(c) (1964).

At the time, no one involved in the debate over this language conceived the "any revisions" exception to be anything other than the limited right to make changes to a preexisting collective work. Indeed, from the perspective of the authors' representatives, their principal concern was to ensure that the "any revisions" language could not be used to enable publishers to edit each contribution to a collective work as part of "revising" it. Copyright Law Revision, Part 5 at 152, J.A. 615a.[6] Not only were authors assured that no such right was intended, they were further assured by publishers' representatives that the "any revisions" language created a narrow exception to the author's copyright in a contribution.

The Magazine Publishers Association, for example, expressed the view that the "any revisions" language granted publishers only "very limited rights." *Id.* at 149, J.A. 611a (statement of A. H. Wasserstrom). Even the publishers viewed this language as applying *only* to "the reproducing and distributing of a contribution *as a part of a particular collective work.*" *Id.* at 159, J.A. 612a (emphasis added). The publishers never envisioned this provision as broadly encompassing a publisher's attempt to create a compendium or collection of collective works, whether in a database or

---

[6] Petitioners contend that this concern somehow supports their overbroad reading of the "any revisions" language. Pet'rs Br. at 31. That contention, however, *assumes* that the authors' groups agreed with the Petitioners' current definition of revision. In reality, neither this statement nor anything else in the legislative history supports the argument that authors signed off on an expansive interpretation of "any revisions" to encompass what Petitioners are now doing. All that can fairly be said is that authors and publishers agreed that the latter could utilize authors' contributions in "any revisions" to—and only to—the particular collective works in which they first appeared.

otherwise. In fact, the publishers' concern was that the "any revisions" language did not cover "the relatively simple and generally accepted right of republication [of the contribution] in the same periodical." *Id.* Both authors and publishers, therefore, viewed the "any revisions" language as confined to reuse of the contribution in an updated version of the same periodical in which the contribution was originally published.

E. The 1965 Draft Bill and Register's Supplementary Report

The publishers' desire for additional clarification of their rights with respect to a contribution led to a further amendment of the provision specifically to authorize use of the contribution in later works "in the same series" of the particular collective work in which the contribution appeared. This amendment, together with the previous language, was incorporated into new section 201(c). The Register's proposed section 201(c) was identical in all respects to the provision codified ten years later in the 1976 Copyright Act:

> Contributions to Collective Works. —Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

Copyright Law Revision, Part 6 at 220. The addition of the "any later collective work" language accommodated the concern that the "revision" language was itself narrow in scope. *See* Copyright Law Revision, Part 5 at 149. In contrast, Petitioners' current reading of "revision" reads the "any later collective work" language right out of existence, a

point properly appreciated by the Second Circuit. *See Tasini v. New York Times Co.*, 206 F.3d 161, 167-68 (2d Cir. 2000).

The principal purpose of section 201(c)—to confirm and preserve the author's copyright in his contribution to a collective work—was reaffirmed in the Register's Supplementary Report on the 1965 Revision Bill. Copyright Law Revision, Part 6 at 68-69, J.A. 625a-626a. Citing to his 1961 Report, the Register emphasized that the 1965 bill "would clarify and simplify the extremely confused and unsatisfactory situation now existing with respect to individual contributions that were not made for hire." *Id.* at 69, J.A. 626a-627a. In particular, the Register noted that:

> In conjunction with the notice provisions of section 403, the second sentence of section 201(c) would preserve the author's copyright in his contribution without requiring a separate notice in his name or an unqualified transfer of all his rights to the publisher.

Id., J.A. 627a.

The Register also provided instructive examples of what the publishers' "privileges" under section 201(c) were intended to encompass:

> Under this presumption, for example, an encyclopedia publisher would be entitled to reprint an article in a revised edition of his encyclopedia, and a magazine publisher would be entitled to reprint a story in a later issue of the same periodical. However, the privileges under the presumption are not intended to permit revisions in the contribution itself or *to allow inclusion of the contribution in anthologies or other entirely different collective works.*

Id. (emphasis added), J.A. 627a.

The illustration given by the Register of the use authorized by the "any revision of that collective work" language is

particularly noteworthy—and demonstrates how far afield the Petitioners' disputed uses of Respondents' contributions fall. That language was intended to entitle an encyclopedia publisher "to reprint an article in a revised edition of his encyclopedia." *Id.* at 69, J.A. 627a. This example says nothing about a compendium of encyclopedias, but is confined to updated versions of the encyclopedia in which the contribution first appeared.[7] No one, including the publishers' representatives, ever conceived of this provision as the sort of broad, multi-media grant that Petitioners now claim it to be.

The Register's emphasis on what section 201(c) was *not* intended to cover reinforces this conclusion. Not only were publishers forbidden from making changes to the contribution themselves, they were *expressly* precluded from incorporating the revision into "anthologies" or "other entirely different collective works." Copyright Law Revision, Part 6 at 69, J.A. 627a. An "anthology" is a "representative collection of selected literary pieces or passages." Webster's Third New International Dictionary 92 (1993 ed.). An "entirely different collective work" was plainly meant to refer to a collective work *other than* the one in which the contribution originally appeared.

The digital media in which Petitioners have republished Respondents' contributions are far closer to "anthologies" of collective works than they are to "revisions" of the particular collective works included in those digital compendiums. As the current Register stated in her recent expression of views on the issues presented by this case:

> What makes today's edition of a newspaper or magazine or any other collective work a "work" under the copyright laws—its selection, coordination and arrangement—is destroyed when its contents are dissembled

---

[7] *See supra* n.3 (discussing how encyclopedias were revised).

> and then merged into a database so gigantic that the original collective work is unrecognizable.

147 Cong. Rec. E182, E183 (daily ed. Feb. 14, 2001), App. B 8a.

In sum, a NEXIS database or a CD-ROM containing daily editions of *The New York Times* more closely resembles a new and different collective work (in fact, a collection of collective works) than mere "revisions" of the particular collective works encompassed within them. The limited privileges accorded publishers under section 201(c) simply cannot, consistent with its legislative history, be stretched to encompass uses that the drafters—inciuding the Copyright Office—never intended or even envisioned.

F. The 1976 House Report

The essential purposes of section 201(c) as set forth by the Register in his 1965 Supplementary Report remained unchanged throughout the next decade culminating in the enactment of the 1976 Copyright Act. The House Report on the 1976 Act emphasized that "one of the most significant aims of the bill is to clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions." H.R. Rep. No. 1476 at 122, J.A. 705a. Echoing the Register's Supplementary Report, the House Report stated that section 201(c) would "preserve" the author's copyright in his contribution without requiring a separate copyright notice and without mandating any "unqualified transfer" of rights to the publisher. *Id.* This was, in the words of the House Report, the "basic presumption" of section 201(c), which was characterized as "fully consistent with present law and practice, and represents a fair balancing of equities." *Id.* at 122, J.A. 706a.

The privileges accorded publishers under the last clause of section 201(c) were viewed by the House Report as "an essential counterpart of the basic presumption." *Id.* But they were, nonetheless, intended to grant rights to use the author's

contribution only "under certain *limited* circumstances." *Id.* (emphasis added). The examples given of this limited grant paralleled those given by the Register in his 1965 Supplementary Report; with respect to "revisions," the only example given was that a publisher would be authorized to "reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it." *Id.* The publisher would *not* be authorized to include the contribution in a "new anthology" or "an entirely different magazine or other collective work." *Id.* at 122-23, J.A. 706a.

These characterizations of section 201(c) in the most definitive source of legislative history for the 1976 Copyright Act cannot be reconciled with Petitioners' attempt to rewrite the statute. The three central themes of that legislative history that were established in the years from 1961-1965 are all evident from the 1976 Report:

- The primary purpose of section 201(c) was to secure authors' rights in contributions to collective works.
- The "privileges" granted to publishers under section 201(c) were intended to be narrow exceptions to authors' copyrights in their contributions.
- The privilege accorded publishers to reproduce and distribute authors' contributions in "any revision of that collective work" was limited to use of the contributions in updates of the particular collective work in which those contributions originally appeared. The privilege does not extend to use of authors' contributions in collections of collective works, regardless of the media in which those collections are reproduced and distributed.

G. The Current Register's Views

In response to a recent Congressional inquiry, Marybeth Peters, Register of Copyrights, strongly agreed with this

reading of the legislative history of section 201(c). Like her predecessor more than 35 years ago, she viewed the scope of the section 201(c) "any revision" privilege as narrow and confined to a "new, amended, improved or up-to-date version of the original collective work." 147 Cong. Rec. E182, E183 (daily ed. Feb. 14, 2001), App. B 8a. She viewed the legislative history's examples of "an evening edition of a newspaper or a later edition of an encyclopedia" as retaining "elements that are consistent and recognizable from the original collective work so that a relationship between the original and the revision is apparent." *Id.* No such elements are recognizable in NEXIS, where the only similarity to the original collective works consists of the *authors'* contributions. *Id.*

The Register of Copyrights, both in the years leading up to enactment of the 1976 Copyright Act and now, has unique insight into the intricacies of Congress' consideration of copyright legislation. The Register firmly believes that the Petitioners' interpretation of section 201(c) and its legislative history is without foundation in the language, purpose and history of that provision. She urges, as do Respondents' *amici* here, that the Second Circuit decision be affirmed – a result, as demonstrated here and in the Register's recent letter, fully in accord with a balanced and commonsense reading of the statute and its legislative history.

II. THE DIRE CONSEQUENCES PREDICTED BY PETITIONERS AND THEIR AMICI ARE OVERSTATED AND MISLEADING

Petitioners claim that affirmance of the Second Circuit's decision in this case would produce "devastating real world effects." Pet'rs Br. at 49. They assert that publishers will have "no alternative" but to destroy CD-ROMs and delete freelance authors' contributions from electronic archives. *Id.* Petitioners' amici go even further by predicting that the

public interest in preserving a complete historical record in the form of electronic archives would be endangered if this Court were to uphold the Second Circuit's decision. *See* Brief for Advance Publications, Inc. *et al.*, at 4-10 (filed Jan. 5, 2001); Brief *Amici Curiae* of Ken Burns *et al.*, at 5-11 (filed Jan. 5, 2001).

These predictions of disaster are overstated, misleading and incorrect as a matter of law and practicality. *First*, Petitioners and their *amici* confuse the right with the remedy. The question before this Court is whether section 201(c) authorizes the reuse of respondents' copyrighted works in various electronic media. If the Court concludes, based on its analysis of the statute and its legislative history, that section 201(c) does not confer the privilege asserted by Petitioners, the case will presumably be remanded to the district court to determine the appropriate remedies. At that time, Petitioners' concerns about the potential impact of permanent injunctive relief on electronic archives could be appropriately considered. Petitioners may then argue, if they wish, that such relief should not be granted.

Second, while petitioners and their *amici* appear to presume that purging of electronic archives would be an inevitable consequence of an affirmance, that is not necessarily so, as the Register recently made clear in her letter expressing her views on the issues presented by this case. 147 Cong. Rec. E182, E183 (daily ed. Feb. 14, 2001), App. B 9a. ("[A]n injunction to remove these [authors'] contributions from electronic databases is by no means a required remedy in Tasini."). The statute vests broad authority in district courts to fashion appropriate injunctive relief; it does not require that permanent injunctive relief be granted in every case in which infringement is proved. 17 U.S.C. § 502(a) (the district court "may . . . grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright"). *See Weinberger v. Romero-Barcelo*, 456 U.S. 305, 313 (1982) (a

federal judge "is not mechanically obligated to grant an injunction for every violation of law"); *accord Friends of the Earth, Inc. v. Laidlaw Envtl. Servs. (TOC), Inc.*, 528 U.S. 167, 192 (2000); *Amoco Prod. Co. v. Village of Gambell*, 480 U.S. 531, 541-43 (1987). Instead, in "exercising their sound discretion, courts of equity should pay particular regard for the public consequences in employing the extraordinary remedy of an injunction." *Weinberger*, 456 U.S. at 311.

Third, should the district court on remand conclude that permanent injunctive relief is inappropriate, the court retains the authority to award respondents a "continuing royalty" for petitioners' future use of individual copyrighted articles included in electronic archives or other digital media. *See* 3 Nimmer on Copyright § 14.06[B], at 14-120 (2000). In *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), four Justices of this Court endorsed the view that a district court might choose to award a continuing royalty or a limited injunction rather than issue broad injunctive relief. *Id.* at 499-500 (Blackmun, J. dissenting) (the majority did not need to reach the issue); *accord Dun v. Lumbermen's Credit Ass'n*, 209 U.S. 20, 23 (1908); *Universal City Studios v. Sony Corp. of Am.*, 659 F.2d 963, 976 (9th Cir. 1981), *rev'd on other grounds*, 464 U.S. 417 (1984). Indeed, the Ninth Circuit has held that continuing royalties—and not an injunction—are mandated by public policy when the effect of an injunction would have been to deprive the public of the opportunity to watch the film *Rear Window*. *See Abend v. MCA, Inc.*, 863 F.2d 1465, 1479 (9th Cir. 1988), *aff'd on other grounds sub nom. Stewart v. Abend*, 495 U.S. 207 (1990) (concluding that "special circumstances" existed justifying the denial of permanent injunctive relief despite a finding of infringement); *see also Richard Feiner & Co. v. Turner Entm't Co.*, 98 F.3d 33, 35 n.3 (2d Cir. 1996) (questioning whether an injunction would be appropriate if it would deprive the public of certain Laurel and Hardy short films). Moreover, the current Register of Copyrights has

expressed the view that given the potential impact of an injunction on scholarship and research, any remedy in this litigation "should be limited to a monetary award that would compensate the authors for the publishers' past and continuing unauthorized uses of their works." 147 Cong. Rec. E182, E183 (daily ed. Feb. 14, 2001), App. B 10a.

In *Sony*, Justice Blackmun expressed confidence that district courts would be able to fashion appropriate relief in copyright cases. 464 U.S. at 500. His warning that "the difficulty of fashioning relief and the possibility that complete relief may be unavailable, should not affect our interpretation of the statute" is as apt today as it was then. *Id.*

Third, despite the alleged impossibility of negotiating fair compensation with authors for the reuse of their contributions in digital media, Petitioners and their *amici* have yet to give it a fair try. In fact, many organizations, including, for example, the American Society of Media Photographers and its collective licensing initiative, the Media Photographers Copyright Agency, are ready and able to facilitate compensation discussions between authors and publishers. Other organizations, such as the Copyright Clearance Center ("CCC") and the Publications Rights Clearinghouse, have established procedures and valuation models for determining compensation for the use of individual copyrighted works by publishers, and those resources can be used by authors and publishers alike to ascertain the fair market value of electronic uses of individual works.[8]

---

[8] *See* Copyright Clearance Center, *CCC Services*, at http://www.copyright.com/Services/services_Portal.html (last visited Feb. 9, 2001); National Writers Union, *About the Publications Rights Clearinghouse*, at http://www.nwu.org/prc/prcabout.htm (last modified July 29, 1999). In the case of stock photography, established rates exist that would be a guide to any determination of the licensing value of stock photographs.

Despite the publishers' protestations of helplessness, they generally have the upper hand in compensation negotiations with individual authors. There is no reason to believe that publishers will not be able to hold their own in compensation discussions with authors. Their reluctance to try suggests that they are simply looking for an excuse, as they have all along, to continue to exclude authors from sharing in the financial rewards generated by the reuse of their contributions in electronic media.

Finally, the irony of Petitioners' forecasts of disaster is striking. Having gone ahead and presumed that section 201(c) shields them from responsibility for compensating authors for reuse of their contributions in electronic media, Petitioners and their publisher *amici* now seek cover from the adverse consequences of their unilateral decisions. They claim that their deeds cannot be undone without harming the public interest, and they claim that negotiations with authors over compensation are impractical. In other words, according to publishers, nothing can effectively be done now to remedy the situation, and the only alternative is to bootstrap their interpretation of the statute to justify their behavior.

This is an arrogant and misguided perspective. Petitioners and their publisher *amici* made a unilateral and presumably informed decision about what they believed section 201(c) allowed them to do with authors' contributions without paying compensation. If this Court concludes that the publishers' interpretation of the statute was wrong, they should not be excused from the consequences of their erroneous interpretation. Their choice would be either to negotiate fairly with authors, or to litigate the question of appropriate remedies before the district courts.

Respectfully submitted,

VICTOR S. PERLMAN
AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS
150 North Second Street
Philadelphia, PA 19106-1912

L. DONALD PRUTZMAN
Counsel of Record
ANDREW BERGER
TANNENBAUM HELPERN SYRACUSE & HIRSCHTRITT LLP
900 Third Ave.
New York, NY 10022
(212) 508-6700

Attorneys for Amici American Society of Media Photographers, Inc. et al.